

REMARKS

Summary of Changes Made

The application was filed with nine (9) claims. The nine original claims are canceled herein and new claims 10-22 are added herein. Basis for the new claims is found in the original claims. The Abstract of the Disclosure is also amended. It now contains 120 words. No new matter is added hereby.

Specification Objections

The Examiner objected to the Abstract as containing incomprehensible language and taking the form of multiple paragraphs.

The Examiner will note that the Abstract is amended herein to conform to a single paragraph having 120 words using acceptable English. The term “homomixer” is known in the art. The objection is thus overcome.

Claim Objections

The Examiner objected to claims 2, 3, and 5 for inclusion of “awkward” language. The Examiner will note that all original claims are canceled and new claims 10-22 are added herein. All present claims are expressed in acceptable English. The objection is thus overcome.

Claim Rejections- 35 U.S.C. 112, 2nd paragraph

Claims 2, 3, 5, and 6 are rejected as indefinite under 35 U.S.C. 112, second paragraph. The Examiner contends that “the [] silicone oil” in claims 2 and 3 lack antecedent basis. In claim 3, the Examiner believes that “polar oil” is indefinite. In claim 5, the Examiner believes that “succinoglycan” and “plasticizers” lack antecedent basis. Also in claim 5, the Examiner believes that “comprising” used in a Markush group leads to indefiniteness. Claim 6 does not cure the indefiniteness of claim 5, hence it is rejected here.

The original claims are canceled thus rendering the rejections moot. Antecedent basis is present in all pending claims.

Polar oils are defined by example in paragraph 35, including disclosure of the various cinnamates. Further polar oils are exemplified in Examples 13-15. Polarity is a relative

term, which is understood by the skilled artisan.

Claim 5 as previously presented, included an acceptable combination of “comprising” and a form of a Markush group. The Markush group did not violate MPEP 2173.05(h), prohibiting the use of “comprising” *within* a Markush group. Currently, the subject matter of claim 5 is found in claims 10 and 15. In neither instance does the Markush group take the improper form “selected from the group comprising....” Claims 10 and 15 thus do not fall prey to the instant rejection. The rejections are thus overcome.

Claim Rejections- 35 U.S.C. 102(b) – (Brieva)

Claims 1, 2, 4, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Brieva, U.S. 5,066,485, (“Brieva”).

The Examiner contends that Brieva discloses compositions comprising oil-in-water emulsions further comprising pigment coated with polysiloxane; a silicone phase; a water phase and a polydiorganosiloxane-polyalkylene copolymeric surfactant (abstract). Brieva further discloses that the coated pigment consists essentially of finely divided particles of pigment whose surfaces are chemically bonded to, and physically completely coated by, polysiloxane which coating renders the particles hydrophobic. Brieva further discloses titanium dioxide and zinc oxide, and such pigments can be coated by a silicone material such as $A_1SiX_1X_2X_3$, where (A) is an alkyl or alkenyl group having 1 to 30 carbon atoms, and X₁, X₂, and X₃ are independently chloro, methoxy, or ethoxy. Brieva further discloses the examples in which the indicated ingredients were combined into an oil phase mixture and a water phase mixture; the two mixtures were then thoroughly mixed to produce a cosmetic product which was an oil-in-water emulsion. The Examiner cites Example 4, disclosing an embodiment where the silicone oils dimethicone and cyclomethicone account for greater than 50% weight of the oil phase and disclose the use of xanthan gum, relating to claims 2 and 4. For claim 9, the Examiner believes that TiO₂ scatters UV light.

The original claims are canceled thus rendering the present rejection moot.

The new independent claims (claims 10, 15 and 22) all contain the subject matter of at least one of claims 3 and 5, which were not rejected hereunder. All remaining claims (11-14 and 16-21) depend from either claim 10 or 15.

Further, Applicants note that the purpose of Brieva is to avoid the problem known as “setting”, in which the attempt to blend high amounts of pigment in to the water phase leads to a product which cannot be applied in a satisfactory manner and results in an uneven,

draggy, streaky appearance upon skin application (column 2, lines 16-22). We believe that the better term for “setting” in Brieva is “settling,” and propose that “setting” in Brieva is a spelling error. We also propose that the term “twisting” used in the instant specification is better rendered by “settling.” This term described in the specification indicates a state of an emulsion applied to the skin. Also, it would be clear that “settling,” is a situation where the applied emulsion becomes nonuniform as shown in the left side of FIG 1 of the instant specification. Thus, it can be considered that Brieva intends to avoid settling.

When blending optional components such as thickeners and humectants in to the emulsion of Brieva, of course, they must be blended at an amount that the intended purpose (to avoid settling) is not undermined. However, as shown in Table 6 of the specification, simply blending a thickener at usual amount level does not avoid settling. Therefore, to achieve the intended purpose of Brieva, only a very low amount of thickener (only so much as does not cause settling) can be blended, for example the small amounts of xanthan gum the Examples of Brieva.

Indeed, present Example 37 (Table 7 of the present specification), teaches blending 0.01 wt% of succinoglycan, which does not lead to a thickening property. Also, when 0.05 wt% of succinoglycan (test example 39) was blended, settling had already occurred although the thickening property was obtained. Thus, if the skilled artisan tries to obtain the thickener, undesired settling also occurs. Because Brieva intends to avoid settling as noted above, it is impossible to blend a thickener at an amount enough to obtain the thickening property. In contrast, the present invention achieves the thickening property by blending the thickener (succinoglycan) without causing settling.

In the present invention, a plasticizer such as glycerin is blended together with the thickener in order to avoid settling. Based on the foregoing, all claims are novel over Brieva.

Claim Rejections- 35 U.S.C. 103(a) – (Brieva/Gers-Barlag/Knipper)

Claims 3, and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brieva in view of Gers-Barlag, U.S. 2002/0054890, (“Gers-Barlag”) and Knipper, U.S. 5,514,792, (“Knipper”). In particular, the Examiner points out that claims 8 and 9 are rejected as being obvious in embodiment wherein the hydrophobized powder is zinc oxide.

As all original claims are canceled herein, the rejection is moot. The Examiner admits that Brieva fails to disclose the use of 12-hydroxystearate or succinoglycan in an emulsion, and cites Gers-Barlag and Knipper, respectively, for the missing subject matter.

The Examiner, in making the present rejection, the Examiner admits that claims 3, and 5-9 and any claim containing such subject matter, is novel over Brieva alone.

The citations of Gers-Barlag and Knipper are inapt. Gers-Barlag relates to a Pickering emulsion composition that lacks an emulsifier and uses a wax ester thickener and includes particles that exhibit both hydrophilic and lipophilic properties. The reference defines a Pickering emulsion as one lacking an emulsifier, instead using metal salts such as sulfates to stabilize the emulsion, paragraph 19. The purpose of Gers-Barlag is to avoid emulsifiers in cosmetic compositions. Hence, the reference teaches away from such use, and teaches away from combination with a reference such as Brieva.

Knipper relates to methods of making succinoglycans with scant discussion of how to use them. Broad statements of using succinoglycans in a “thickening, stabilizing or suspending agent[] in [] cosmetic [] compositions,” are as specific as Knipper gets in this regard.

Brieva discloses the optional use of glycerin (glycerol) as a humectant. However, Brieva does not teach that it is possible to blend a thickener at an effective amount without settling by using it in combination with a plasticizer. If so, succinoglycan taught by Knipper, and 12-hydroxystearate taught by Gers-Barlag, cannot be blended at the effective amount for a thickening property even if it was possible to blend glycerin in to the emulsion. Because, Brieva and person skilled in the art should recognize that thickeners causes settling as shown by the test example 39 of Table 7, and this recognition is that blending the effective amount of succinoglycan undermines the intended purpose of Brieva. Therefore, it is *not* obvious from the teachings of Brieva and Knipper that an amount of succinoglycan blends in combination with glycerin (plasticizer) effective to obtain a thickening property can be added without causing settling. Similarly, it is not obvious from the teachings of Brieva and Gers-Barlag that an amount of 12-hydroxystearate in combination with glycerin (plasticizer) effective to obtain a thickening property can be added without causing settling.

The newly added claims are thus patentable over the three-way art combination.

Comment – Priority Documents

Taking together the Examiner's explicit acknowledgement of the priority of the application, with fact that box "C" is checked under item 12 on the Office Action Summary page and the presence of the 39 page priority document (WO/2004032361) in Private Pair, it is believed that box (a) of item 12 should be checked, because the Office has the priority document of record. If this is in error, the Examiner is respectfully requested to address this issue explicitly in the next Office Action.

CONCLUSION

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application. If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. IWI-16045.

Respectfully submitted,

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